REMARKS

This amendment is in response to a non-final Office action (Paper No. 39) mailed April 21, 2005. Upon entry of this amendment, claims 1-4, 17, 25, 26 and 29-52 will be pending. Applicant has cancelled claims 24, 27, 28 and 44 without prejudice or disclaimer as to their subject matter by this amendment, amended claims 1, 3 and 26 by this amendment and newly added claims 50-52 by this amendment.

In Paper No. 39, the Examiner rejected claim 3 under 35 U.S.C. 112, second paragraph for a single incident of no antecedent basis. Applicant has amended claim 3 by this amendment to overcome this rejection.

Applicant notes that Paper No. 39 is devoid of any prior art rejection of claim 3 nor does Paper No. 39 indicate that claim 3 is allowable. Applicant submits that this failure of the Examiner to examine claim 3 in Paper No. 39 is a violation of general patent practice, compact prosecution, MPEP 2173.06 and 37 C.F.R. 1.104 (b). Applicant submits that claims rejected for "technical reasons" must be examined. In Paper No. 39, the Examiner rejected claim 3 for one antecedent basis problem without applying any prior art against claim 3. Applicant objects to this piecemeal examination of Paper No. 39.

In Paper No. 39, the Examiner rejected claims 1, 2, 24, 25, 29, 31, 35, 36, 44 and 45 under 35 U.S.C. 102 (b) as being anticipated by newly cited USP 5,198,802 to Bertram et al. The

Examiner also rejected claims 17, 30, 38 and 46-49 under 35 U.S.C. 103 (a) as being unpatentable

over USP 5,648,781 to Choi in view of Bertram '802. The Examiner also rejected claims 26-28, 32-

34, 37 and 39-43 under 35 U.S.C. 103 (a) as being unpatentable over Bertram '802. In this

amendment, Applicant has amended claim 1 to now include the subject matter of depending claim

24 as Applicant believes that the prior art rejection of claim 24, along with the prior art rejection of

independent claims 31 and 39 in Paper No. 39 were improper. Applicant will now explain why.

Applicant's invention pertains to a remote control having a trackball and a button, the remote

control interacts with menus on a display. The user manipulates the trackball to move a cursor on

the display to an item on the menu, selects that menu item by depressing a button on the remote

control, causing a submenu to appear and causing the cursor on the display to jump automatically

to the submenu.

Bertram '802 seeks to improve the effectiveness of combining keyboard entry with mouse

entry (see col 1, lines 15-18). Both keyboard and mouse are wireline, and the mouse has a trackball.

In Bertram '802, the automatic repositioning of a cursor occurs only when selection of a menu item

is done via keyboard. The automatic repositioning does not occur when the menu selection is

accomplished via the mouse. Bertram sets it up this way so that cursor control is intuitively obvious

to a user as it is discussed in column 2, lines 3-10 of Bertram '802, because operating systems do not

ordinarily reposition the cursor upon menu selection when it is the mouse and not the keyboard

controls the cursor. Thus, Bertram '802 as a whole is not about cursor repositioning, Bertram '802

as a whole is about how to interwork a mouse operating program with a keyboard operating program when there is only one cursor on a display so that the user does not get confused.

Applicant's invention discusses cursor control using a remote control with a trackball, which is more akin to the mouse in Bertram '802 than the keyboard. This is because the mouse in Bertram is more remote than the keyboard and the mouse in Bertram has a trackball to gradually slide the cursor across the display as opposed to moving the cursor in increments. Also, like Applicant's remote control, the mouse in Bertram moves the cursor across the display gradually as opposed to incrementally when the keyboard in Bertram is used to move the cursor. Because it is the keyboard and not the mouse of Bertram '802 where automatic cursor repositioning occurs, Applicant submits that Bertram '802 does not teach Applicant's claimed invention. This is because Bertram '802 as a whole teaches that one having ordinary skill would expect that a mouse or a remote control will not be able to and should not be able to cause the cursor to be automatically repositioned when it is the mouse or remote control that makes a menu selection. In fact, Bertram '802 teaches away from Applicant's invention because Bertram '802 makes very clear (see column 2, lines 3-10 of Bertram for example) that the remote mouse with the trackball that causes the cursor to gradually move across the display does not cause the cursor to be repositioned upon menu selection. For this reason, the 102/103 claim rejections using Bertram of Paper No. 39 are without merit.

Regarding claims 17, 30, 38 and 46-49, the Examiner used Choi '781 in view of Bertram '802. Choi '781 teaches a wireless remote controller with a trackball that can move a cursor on a

display. Choi '781 is absent of the automatic cursor repositioning features. In Paper No. 39, the Examiner turns to Bertram '802 for a teaching of the automatic cursor repositioning features. Then, the Examiner submits that Choi '781 as modified according to Bertram '802 would result in Applicant's invention. Applicant disagrees.

Applicant submits that to one having ordinary skill in the art, Choi '781 as modified according to Bertram '802 would result in Applicant's invention. Applicant submits that if Choi '781 were to be modified according to Bertram '802, the result would be two cursor moving devices operating together. However, Applicant submits that if Choi '781 were modified according to Bertram '802, it would not be the mouse or remote control cursor moving device that repositions the cursor. Instead, the resultant would only allow the keyboard cursor moving device to trigger an automatic repositioning of the cursor. This is because Bertram '802 teaches that it is only the keyboard and not the mouse that causes the cursor to be automatically repositioned when a selection of a menu item is made. Thus, the combination of Choi as modified according to Bertram would be a remote and a keyboard where the remote can result move the cursor but will not cause the cursor to skip when a menu selection is made. In the combination, it would be the keyboard and only the keyboard that causes the cursor to skip because mouse operating programs do not cause the cursor to skip. Thus, the combination of Choi and Bertram can not teach the remote mouse with trackball to trigger automatic repositioning of the cursor upon menu selection. For this reason, Applicant submits that Choi '781 as modified according to Bertram '802 would not result in Applicant's claimed invention. Therefore, the rejection of claims 17, 30, 38 and 46-49 must be withdrawn.

Applicant will now discuss why specific claimed features are not present in either Choi '781 or Bertram '802, either taken singly or in combination.

Regarding claims 29, 35 and 43, Applicant claims that when a submenu is reverted back to a main menu, the cursor is automatically repositioned to *the selected* main menu item. Applicant submits that this feature is not present in the applied prior art.

In Paper No. 39, the Examiner says that this feature is taught by FIG. 5B and column 6, lines 55-64 of Bertram. Applicant disagrees. Applicant submits that when the keyboard in Bertram is used to revert back to the recalled screen, the cursor is automatically repositioned to *the top, left selection* of the recalled screen, not to the selected item of the recalled screen. Nowhere does Bertram teach that the cursor is automatically repositioned to the selected item of the recalled screen as in Applicant's claimed invention. In Bertram, if "personal software" is selected in the main menu and a submenu appears, and the user in Bertram uses the keyboard to revert back to the main menu, the cursor will be repositioned on "information" and not on "personal software" in the recalled screen. For this reason, Applicant submits that the limitations of claims 29, 35 and 43 are not present in any of the applied prior art.

Regarding claim 30, Applicant claims the automatic repositioning of the cursor upon enlargement/reduction of the menu. On pages 7 and 8 of Paper No. 39, the Examiner states that this feature is taught by column 5, lines 45-49 of Bertram '802. Applicant disagrees. Applicant submits

that column 5, lines 45-49 of Bertram '802 pertains to FIGS. 2A, 2B and 2C of Bertram '802, which is about selecting a menu item and displaying a submenu, not about enlargement or reduction.

Regarding claim 37, Applicant also claims the automatic repositioning of the cursor upon menu enlargement and reduction. On Page 11 of Paper No. 39, the Examiner now says that Bertram '802 does not teach this feature, but then states that "It would have been obvious to one of ordinary skill in the art at the time of the invention was made to replace the rectangles in which the four categories are represented in Fig. 2A by any desired size of geometric figure because the geometric sizes are a matter of choice handled by a utility software as taught by Betram (col. 5, lines 26-36)". Applicant has reviewed col 5, lines 26-36 of Bertram and can not find any reference to sizes of geometric figures as alleged by the Examiner in Paper No. 39.

Regarding claims 33 and 34 and apparatus claim 17, Applicant claims the cursor being at a geometric center of an item of a menu or submenu. On pages 10 and 11 of Paper No. 39, the Examiner states that column 5, lines 37-42, lines 50-53 and FIG. 2B of Bertram or FIG. 3 (72) and col 4, lines 29-31 of Choi '781 teaches this feature. Applicant disagrees. Applicant submits that FIG. 2B of Bertram shows cursor 17 at the right of an item in a submenu, not at a geometric center of an item. Further, Applicant has reviewed column 5, lines 37-42 and lines 50-53 of Bertram and cannot find any discussion of where the cursor is positioned within an item, not to mention geometric center of an item. In addition, Applicant has reviewed the cited portions of Choi '781 and cannot find any discussion as to where in the item the cursor is positioned.

Applicant has amended claim 26 and newly added claims 50-52 to emphasize features in Applicant's invention that are clearly not present in Bertram, such as both the trackball and the selection key being both on the remote control and the cursor being automatically repositioned to a geometric center of a menu item. Entry of and favorable examination of these claims is respectfully requested.

No fees are incurred by the filing of this amendment.

In view of the foregoing amendments and remarks, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. If there are any questions, the Examiner is asked to contact the Applicant's attorney.

Respectfully submitted,

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